

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action dated November 10, 2004, regarding the above-referenced application. Currently, claims 31-52 are pending in the application, wherein claims 31-37, 40-48 and 51-52 are rejected and claims 38-39 and 49-50 are withdrawn from consideration. Claims 36, 38-39, 47 and 49-50 are cancelled with this amendment. Favorable consideration of the following remarks prepared in view of the Office Action is requested.

Claims 36 and 47 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 36 and 47 have been cancelled with this paper, thus obviating the rejection without conceding the appropriateness of the rejection.

Claims 31-37, 40-46, 48 and 51-52 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nott et al. (U.S. Patent No. 5,709,704). The Examiner asserts Nott disclose in Figs. 5-6, a device for trapping and removing plaque or embolic material from a blood vessel as currently claimed. Applicants respectfully traverse this rejection.

Claim 31 recites in relevant part, "a filter coupled to the shaft adjacent the distal end." Applicants assert Nott at least fails to teach this limitation of the claimed invention. Applicants assert the prior art reference must teach the claimed invention in as much detail, including all structural limitations, as provided in the rejected claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Nott clearly fails to satisfy such an evaluation.

The Examiner suggests Nott teaches an elongate shaft (132) coupled to a filter (10). However, element 132 (teflon sheath) is not coupled to the filter 10. This is apparent not only by observing Figure 5, but also through the accompanying description in the specification. See column 7, lines 27-42. The sheath 132 may be advanced through a vessel to a desired location. Once the distal end of the sheath is properly positioned in a vessel, a pusher 134 may be used to advance filter 10 through the sheath 132 to the distal end of the sheath. The sheath is then pulled back while the pusher abuts the filter and holds the filter 10 in the desired position. Once the filter is released, the sheath and the pusher can be withdrawn from the vessel together. At no point does Nott suggest the sheath 132 is coupled to the filter 10, and it is apparent from the teachings of Nott that the filter 10 is disposed within the sheath 132, and not coupled thereto. In other words, the filter 10 is not attached to the sheath 132. One of ordinary skill in the art would not consider the filter 10 coupled to the sheath 132. Likewise, the filter 10 is not coupled to the pusher 134, either. Reasserting that an anticipatory reference must teach the rejected claim in sufficient detail, including all structural limitations, Nott fails to teach the invention as claimed in claim 31.

Applicants assert that Nott fails to anticipate claim 31 at least because Nott fails to suggest a filter coupled to an elongate shaft. Therefore, claim 31 is believed to be patentable over Nott. Claims 32-35 depend from claim 31 and add significant additional elements; therefore, they are also believed to be in condition for allowance.

Claim 37, similar to claim 31, recites in relevant part, "a filter coupled to the shaft adjacent the distal end." As discussed above, Nott fails to teach at least this limitation of the claimed invention. Therefore, claim 37 is believed patentable over the teachings of

Nott. Claims 40-41 depend from claim 37 and add significant additional elements; therefore, they are also believed to be in condition for allowance.

Claim 42 teaches an embolic protection filtering device comprising a guidewire, wherein a filter is coupled to the distal end region of the guidewire. Applicants assert Nott fails to teach a guidewire as currently claimed. At no point does Nott suggest the use of a guidewire in conjunction with the invention. Furthermore, the filter taught in Nott is not coupled to any other element which may be construed to be a guidewire. Thus, every element and structural limitation of the claimed invention is not taught by the reference. Therefore, Nott clearly does not anticipate the invention as claimed in claim 42. Claims 43-46 depend from claim 42 and add significant additional elements; therefore, they are also believed to be in condition for allowance.

Claim 48, similar to claim 42, teaches an embolic protection filtering device comprising a guidewire, wherein a filter is coupled to the distal end region of the guidewire. Therefore, as stated above, Nott fails to teach the invention as claimed in claim 48. Claims 51-52 depend from claim 48 and add significant additional elements; therefore, they are also believed to be in condition for allowance.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

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By their Attorney,

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